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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/624,527	07/23/2003	Kouetsu Hibino	10517/177	6668

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EXAMINER

RHEE, JANE J

ART UNIT	PAPER NUMBER
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1745

DATE MAILED: 02/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/624,527	Applicant(s) HIBINO ET AL.	
	Examiner Jane Rhee	Art Unit 1745	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/2/2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Rejections Withdrawn

1. The 35 U.S.C. 102(b) of claims 1,2,6-7,10 anticipated by Mizuno et al. has been withdrawn due to applicant's argument filed on 12/2/2005.
2. The objection to allowable subject matter of claims 3-5,8-9,11 has been withdrawn due to applicant's argument filed on 12/2/2005.

New Rejections

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-9,11 are rejected under 35 U.S.C. 102(b) as being anticipated by Collins et al. (6322915).

As to the preamble, a fuel cell purposed separator is not given any patentable weight. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

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As to claims 1 and 6 Collins et al. discloses a gas passage having a plurality of stages that are connected via a turnaround portion (figure 5 number 128), and a bypass that connects an upstream side stage of the gas passage to a downstream side stage of the gas passage and that causes a gas that flows in via a gas inlet of the bypass to flow out of a gas outlet (figure 5 number 124). Collins et al. teaches that the gas inlet and the gas outlet are located at a same side of the separator (figure 6 number 144 and 142). As to claims 2 and 7, Collins et al. discloses that the gas passage is defined by a sidewall of the separator and a rib or by two ribs (figure 5 number 136,138). As to claims 3,5, 8, and 11 the gas inlet to the flow field is located in a lower portion of the separator and the gas outlet from the flow field is located in the upper portion of the flow field (figure 5 number 130,132). As to claims 4 and 9, Collins et al. discloses that a bypass outlet of the bypass and a distal end of a downstream side partition rib overlap in a horizontal direction (figure 5 number 130). As to claim 10, Collins et al. teaches that the bypass is located at a side of the separator opposite from the gas inlet and the gas outlet (figure 2 numbers 50-52).

4. Claims 1,2,6-7,10 are rejected under 35 U.S.C. 102(b) as being anticipated by Mizuno et al. (6387558).

As to claim 1 and 6, Mizuno et al. discloses a fuel cell separator comprising a gas passage having a plurality of stages that are connected via a turnaround portion (figure 13 number 640, 642 figure 5 number 60), and a bypass that connects an upstream side stage of the gas passage to a downstream side stage of the gas passage and that

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cases a gas that flows in via a gas inlet of the bypass to flow out of a gas outlet (figure 13 numbers 690). As to claims 2 and 7, Mizuno et al. discloses that the gas passage is defined by a side wall of the separator and a rib or by two ribs (figure 13 number 640). Mizuno et al. teaches that the gas inlet and the gas outlet are located at a same side of the separator (figure 13 number 640 and 642). As to claim 10, Mizuno et al. teaches that the bypass is located at a side of the separator opposite from the gas inlet and the gas outlet (figure 13 numbers 640, 642).

Response to Arguments

5. Applicant's arguments filed have been fully considered but they are not persuasive.

In response to applicant's argument that Mizuno does not disclose a bypass that connects an upstream-side stage of a gas passage of a separator to a downstream stage of the gas passage, in figure 13 the bypass is 690 and the gas passage is 640 and 642 which is more clearly seen in figure 5. Therefore, Mizuno et al. teaches a bypass that connects an upstream side stage of a gas passage of a separator to a downstream stage of a gas passage as shown in figure 13.

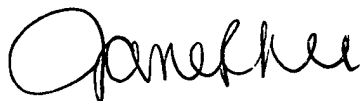
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jane Rhee whose telephone number is 571-272-1499. The examiner can normally be reached on M-F 9-6.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Ryan can be reached on 571-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jane Rhee
February 8, 2006



PATRICK JOSEPH RYAN
SUPERVISORY PATENT EXAMINER